

Applicant's Independent Claim 1 requires a water-excluding valve assembly for a diving snorkel having a cap, an upper piece with a top and a bottom having a plurality of longitudinally spaced openings about its circumference. Claim 1 further requires a lower piece with a top and a bottom and having a plurality of longitudinally spaced openings about its circumference. Further, Applicant's Claim 1 requires a plurality of hollow, longitudinal posts in communication with the upper piece and the lower piece at their longitudinally spaced openings. Still further, Claim 1 requires that the assembly of the upper piece, the lower piece and the posts form a cage. A spherical float is held captive within the cage.

Lin does not disclose a plurality of hollow, longitudinal posts in communication with an upper piece and a lower piece at longitudinally spaced openings as required by Applicant's Claim 1. The plurality of hollow, longitudinal posts of Applicant's invention are used to transport air from the atmosphere to the person. Further, the plurality of hollow, longitudinal posts creates a cage in which the spherical float is held captive.

Lin merely discloses an annular upper body and an annular lower body wherein the upper and lower body each have a plurality of grid-shaped holes and further wherein the annular upper body and annular lower body are in communication and form a cage. Nowhere in *Lin* are a plurality of hollow, longitudinal posts used to transport air from the atmosphere to the person. Instead, the plurality of grid-shaped holes in *Lin* merely allow air to enter the snorkel where it enters a single intake hollow shaft 41. More specifically, the longitudinal posts which create the cage of *Lin* are not hollow and do not allow the passage of air. Accordingly, the rejection of Claims 1-4 under 35 U.S.C. §103(a) as being unpatentable over *Lin* in view of *Wayfield* should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 1-4 under 35 U.S.C. §103(a) as being unpatentable over *Wayfield* in view of *Lin*, Applicant respectfully submits that this rejection is also improper and should be withdrawn for the same reasons as stated above. With respect to these rejections, the Office action states "[Claims 1-4] are readable on the patent to [*Wayfield*] with the single exception of having the hose barb at the bottom of a valve cage opposed to the top with the top be closed off or with a cap. The patent to *Lin* teaches the above exception. In view of the teaching of *Lin*, it would be obvious to one

of ordinary skill in the art, at the time the invention was made, to provide the above exception to the device of [*Wayfield*] to position element 35 at the bottom of cage 37 in the same manner as taught by elements 31, 32, 34 and 38, if desired.”

As stated above, Applicant submits that nowhere in *Lin* nor *Wayfield* are a plurality of hollow, longitudinal posts in communication with an upper piece and a lower piece present. *Wayfield* merely discloses a cage having a spherical float wherein the cage is formed by solid posts which do not allow the transportation of air from the atmosphere to the person. Accordingly, the rejection of Claims 1-4 under 35 U.S.C. §103(a) as being unpatentable over *Wayfield* in view of *Lin* should be withdrawn. Notice to that effect is requested.

In the alternative, Applicant submits that even if all the elements of Applicant’s invention were present in *Lin* and *Wayfield*, a rejection under §103 would be improper. It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant’s water-excluding valve assembly for a snorkel. A teaching, suggestion, or incentive must exist to make the combination made by the Applicant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Lin* and *Wayfield* in mind, as enumerated above, no reason or suggestion in evidence of record exists why one of ordinary skill in the art would have been led to modify *Lin* with *Wayfield* in the manner suggested by the Patent Office in formulating the rejection under U.S.C. §103. Therefore, prima facie obviousness has not been established by the Patent Office as required under U.S.C. §103.

Claims 2-4 depend from Claim 1. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claim since each sets forth additional novel elements of Applicant's novel water-excluding valve assembly for a diving snorkel.

In view of the foregoing remarks, Applicant respectfully submits that all of the claims in the application are allowable. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



Dr. Sharon H. Roddan (Reg. No. 43,053)

~~86 Monarch Bay~~

~~Monarch Beach, CA 92629-3435~~

Ph: (949)499-2700

Fx: (949)499-6205

22882 Montalvo Rd.

Laguna Niguel, CA 92647

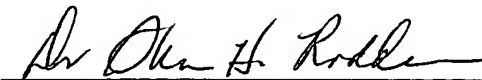
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